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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,351	03/27/2002	Dana Paul Gruenbaccher	8278	1392

27752 7590 03/11/2003

THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
WINTON HILL TECHNICAL CENTER - BOX 161  
6110 CENTER HILL AVENUE  
CINCINNATI, OH 45224

EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 03/11/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/089,351

Applicant(s)  
Gruenbacher et al.

Examiner  
Kathleen J. Prunner

Art Unit  
3751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 9, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 27, 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

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## DETAILED ACTION

### *Priority*

- not*
1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

### *Drawings*

2. The drawings are objected to because Fig. 61 is not properly labeled as such. A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings **must show every feature** of the invention **specified in the claims**. Therefore, (A) the opening, as called for by claim 1; (B) the massaging structure or feature, as called for by claim 11; (C) the massaging structure or feature positioned behind the first external side, as called for by claim 11; and (D) the structures as called for by claim 12, must be shown or the features canceled from the claims. No new matter should be introduced or it will not be entered.

A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. Applicant is required to submit a proposed drawing correction **in reply to this Office action** in order to avoid abandonment of the application. Any proposal by the applicant for amendment of

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the drawing to cure defects **MUST** be embodied in a **SEPARATE LETTER to the Draftsman**. See MPEP §608.02(r). The objection to the drawings will not be held in abeyance.

***Specification***

5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

6. <sup>drop</sup> The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

7. <sup>drop</sup> The following title is suggested: A Semi-enclosed Applicator Having A Heating and/or Cooling Element.

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

9. <sup>keep</sup> The disclosure is objected to because of the following informalities: (A) on page 3, in the paragraph beginning on line 11, "a first side having a first internal surface and a first external surface" has been described; however, the description beginning on line 14 of page 7 fails to describe what structure constitutes such a first side having a first internal surface and a first external surface; and (B) on page 3, in the paragraph beginning on line 11, "a second side having a second internal surface and a second external surface" has been described; however, the description beginning on line 14 of page 7 fails to describe what structure constitutes such a second side having a second internal surface and a second external surface. Appropriate correction is required.

10. The following informalities in the specification are noted: <sup>drop</sup> (A) on page 15, line 24 contains underlining (only Reissue applications can contain underlined portions); <sup>drop</sup> (B) line 1 on page 43 and line 4 on page 45 contain a blank, i.e., incomplete information for a U.S. application; <sup>drop</sup> (C) on page

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38, line 28, and page 49, line 17 contain italics (only Reissue applications can contain italic portions); <sup>drop</sup>(D) on page 48, line 10, "polyester" is misspelled; and <sup>keep</sup>(E) on page 60, line 17, "53" should read --57--. Appropriate correction is required.

11. The following informalities in the claims are noted: <sup>drop</sup>(A) in claim 2, on line 2, --said-- should be inserted before "first"; <sup>drop</sup>(B) in claim 5, on line 3, "type" should read --used--; and <sup>drop</sup>(C) in claim 9, on line 2, "sides" should read --side--. Appropriate correction is required.

*keep*

***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 3 and 10 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The specification, from line 26 on page 40 to line 3 on page 41, and the drawings

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(note Figs. 53-58) supports that the heating/cooling element, when used in combination with a mitt, forms an integral part of the mitt. The structural cooperative relationships between the temperature changing element and all of the preceding recited elements of claim 1, i.e., the first and second sides, the internal cavity, the at least one opening, and the flexible film pouch, are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

16. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an internal cavity that is accessible “through an opening” (note line 25 on page 8), does not reasonably provide enablement for “at least one opening”, as called for by claim 1, which purports more than one opening,. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

17. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a mitt to include “a heating and/or cooling element” (note lines 28-29 on page 33), does not reasonably provide enablement for “a temperature changing element”, i.e., an element capable of changing its temperature, as called for by claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

18. Claims 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure fails to support that the embodiment which utilizes the “temperature changing element” can be used for “cleaning, moisturizing, conditioning, or otherwise treating the skin, hair, or nails”, as called for by claim 3. The disclosure also fails to support that the embodiment which utilizes the

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“temperature changing element” can be used with a “product selected from the group consisting of face cleansers, body cleansers, toners, lotions, moisturizers, ointments, cosmetics/make-ups, medicaments, and related topically applied treatments”, as called for by claim 4.

19. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a massaging structure of “rotating or rolling balls/cylinders/rods” (note line 3 on page 53), does not reasonably provide enablement for “balls, cylinders, rods” as called for by claim

12. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

20. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a massaging structure of “three-dimensional patterns embossed, engraved, or otherwise formed in a solid material” (note lines 3-4 on page 53), does not reasonably provide enablement for “three-dimensional patterns embossed within a solid material, three-dimensional patterns engraved within a solid material, and three-dimensional patterns formed within a solid material” as called for by claim 12. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

21. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.

22. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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23. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: (A) the structural cooperative relationships between the flexible film pouch and the preceding recited elements of the second side, the internal cavity and the opening; and (B) the structural cooperative relationships between the temperature changing element and all of the preceding recited elements of the first and second sides, the internal cavity, the at least one opening, and the flexible film pouch. Without such structural relationships, both the flexible film pouch and the temperature changing element could be located at any location external to the applicator, e.g., like a bar of soap is to a wash cloth, which locations are not supported by the disclosure (note Figs. 53-58 and from line 26 on page 40 to line 3 on page 41).

24. Claims 3 and 10 provide for the use of a semi-enclosed applicator, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

25. Regarding claim 9, the phrase "more than one functional sides" renders the claim indefinite since no functional side has been previously recited and it is unclear as to what structure(s) constitute such "functional sides".

### ***Claim Rejections - 35 USC § 102***

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



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27. Claims 1-3, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Helenick. Helenick discloses a semi-enclosed glove applicator having all the claimed features including a first side (constituted by the upper side of glove 10) having a first internal surface and a first external surface (note Figs. 2, 7 and 8), a second side (constituted by the lower side of glove 10) having a second internal surface and a second external surface (note Figs. 2, 7 and 8), an internal cavity having an opening 78 that is externally accessible (note Figs. 1, 3-5 and 12), a flexible film pouch or bladder 17 containing a product constituted by gel 20 located proximately to the first side (note Fig. 2), and a temperature changing element constituted by the thermal material of product 20 (note lines 9-13 in col. 6). The introductory statement of intended use has been carefully considered but is deemed not to impose any structural limitations on the claim distinguishable over that shown by Helenick which is certainly capable of being used in the intended manner if one desires to do so. With respect to claim 2, Helenick also discloses that the temperature changing element is located between the first and second sides (note Fig. 2). With regard to claims 3 and 10, the intended use has been carefully considered but is deemed not to impose any structural limitations on the claim distinguishable over that shown by Helenick which is certainly capable of being used in the intended manner if one desires to do so. With respect to claim 9, Helenick additionally discloses that the product 20 has more than one functional side constituted, e.g., by the upper and lower surfaces (note Fig. 2).

28. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sansonetti. Sansonetti discloses a semi-enclosed applicator in the form of a mitt or mitten 10 having all the claimed features including a first side having a first internal surface and a first external surface constituted by the upper hand portion of the mitt, a second side having a second internal surface and a second external surface constituted by the bottom hand portion of the mitt, an internal cavity constituted by chamber 16 having an opening that is externally accessible (note Fig. 1), a flexible

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film pouch constituted by the membrane 22 containing the product 20 located proximately to the first side (note Fig. 1), and a temperature changing element constituted by heating element 34. The introductory statement of intended use has been carefully considered but is deemed not to impose any structural limitations on the claims distinguishable over that shown by Sansonetti which is certainly capable of being used in the intended manner if one desires to do so. With respect to claim 2, Sansonetti also discloses that the temperature changing element 34 is located between the first and second sides of the mitten (note Figs. 2 and 3). With regard to claim 5, Sansonetti further discloses that the product 20 is a hand cream, which creams are well known to contain such ingredients as emollients, oils and polymers. With respect to claim 6, the product 20 hand cream of Sansonetti inherently has shear-thinning or thixotropic properties since the heat aids in the absorption of the cream (note lines 39-42 in col. 1). With respect to claim 7, the product 20 hand cream of Sansonetti inherently has tactile properties such as greasiness or slipperiness. With respect to claim 9, Sansonetti additionally discloses that the product 20 has more than one functional side constituted, e.g., by the upper and lower surfaces (note Fig. 1).

***Claim Rejections - 35 USC § 103***

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claim 8 is rejected under 35 U.S.C. 103 as being unpatentable over Sansonetti. Although Sansonetti fails to disclose the chemical composition of the product 20 hand cream, using such ingredients as petrolatum, petroleum jelly, castor oil, octocrylene, tocopheryl acetate or non-volatile

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organo-substituted polysiloxanes in the hand cream formula would be an obvious matter of choice to the artisan skilled in the hand cream art depending upon the brand of hand cream used since such ingredients are well known constituents of hand cream formulas.

31. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansonetti in view of Charos. Although Sansonetti fails to disclose that the applicator contains a massaging structure positioned behind the first external side, attention is directed to Charos who discloses another heated hand cream mitt or glove having cavities 2 or 10 on the inner side of the external side (note Figs. 1-3) in order to effect a suction-massage action (note lines 20-24 in col. 2). It would have been obvious to one of ordinary skill in the heated hand cream mitt or glove art, at the time the invention was made, to provide the inner side of the mitt of Sansonetti with cavities in view of the teachings of Charos in order to effect a suction-massage action.

### ***Conclusion***

32. The Examiner is advising attorneys to FAX any response due to Office actions. The U. S. Patent and Trademark Office (USPTO) is experiencing major delays in matching up papers that were mailed. Due to the Anthrax issue, any mail sent to the USPTO is automatically sent to an irradiation center in Virginia. It has been found that the irradiation process makes papers too brittle to handle. Therefore, the irradiation center has to further copy each paper. The originally filed irradiated papers are then placed in a sealed envelope and put in the associated file. After this irradiation process, the "papers" are then sent to the Office where they are matched with the file. This entire procedure causes months in delays due to the quantity of mailed received. Therefore, it is suggested that any response be sent by FAX especially if a time limit is critical. The FAX number for the technical center where this file is located is given in the paragraph below.

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33. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

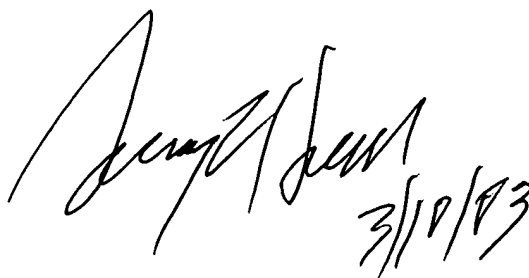
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.



Kathleen J. Prunner:kjp

March 7, 2003



GREGORY HUSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700